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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,462	09/18/2001	Jeffrey Wilusz	601-1-109N	7730

23565 7590 07/29/2002

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 07/29/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,462

Applicant(s)

WILUSZ ET AL.

Examiner

David Lamberson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

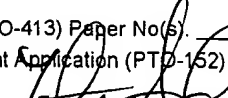
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: 

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 17-21, drawn to mammalian cell extracts containing specific nucleotides, classified in class 536, subclass 22.1.
- II. Claim 14, drawn to a polypeptide, classified in class 530, subclass 300.
- III. Claim 15, drawn to a polynucleotide, classified in class 536, subclass 23.1.
- IV. Claim 16, drawn to an antibody, classified in class 424, subclass 130.1.
- V. Claim 22, drawn to a method for decapping mRNA, classified in class 435, subclass 91.51.
- VI. Claims 23-26, drawn to a method for detecting modulators of mRNA decapping, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The mammalian cell extract (Group I) is unrelated to a polypeptide (Group II) because the inventions are unrelated in structure and function. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

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Inventions Group I and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The mammalian cell extract (Group I) is unrelated to a polynucleotide (Group III) because the inventions are unrelated in structure and function. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group I and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The mammalian cell extract (Group I) is unrelated to an antibody (Group IV) because the inventions are unrelated in structure and function. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group I and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process can be performed with another materially different product, such as an extract from a non-mammalian eukaryotic organism supplemented with the additional materials. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

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Inventions Group I and Group VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process can be performed with another materially different product, such as an extract from a non-mammalian eukaryotic organism supplemented with the additional materials. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group II and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polypeptide (Group II) is unrelated to a polynucleotide (Group III) because the inventions are unrelated in structure and function. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group II and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polypeptide (Group II) is unrelated to an antibody (Group IV) because the inventions are unrelated in structure and function, with each composition directed towards a different outcome and effect. A search of

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one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group II and Group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polypeptide (Group II) is unrelated to a method for decapping mRNA (Group V) because the composition is unrelated in structure and function to the method. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group II and Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polypeptide (Group II) is unrelated to a method for identifying modulators of mRNA decapping (Group VI) because the composition is unrelated in structure and function to the method. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group III and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polynucleotide (Group III) is unrelated to an antibody (Group IV) because the compositions are unrelated in structure and

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function. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group III and Group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polynucleotide (Group III) is unrelated to a method for decapping mRNA (Group V) because the composition is unrelated in structure and function to the method. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group III and Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The polynucleotide (Group III) is unrelated to a method for identifying modulators of mRNA decapping (Group VI) because the composition is unrelated in structure and function to the method. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group IV and Group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The antibody (Group IV) is unrelated to a method for decapping mRNA (Group V) because the composition is unrelated in

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structure and function to the method. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group IV and Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The antibody (Group IV) is unrelated to a method for identifying modulators of mRNA decapping (Group VI) because the composition is unrelated in structure and function to the method. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Inventions Group V and Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The method for decapping mRNA (Group V) is unrelated to a method for identifying modulators of mRNA decapping (Group VI) because the methods comprise different, unrelated steps, with each method directed towards a different outcome. A search of one group would not be co-extensive with a search of the other and hence said search would be burdensome.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Michael Wise on June 26, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
July 26, 2002

DAVID GUZO
PRIMARY EXAMINER
